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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/662,534 | 09/16/2003 | Kaoru Iwato | Q77005 | 9429 |

23373 7590 03/09/2005
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

THORNTON, YVETTE C

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
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1752

DATE MAILED: 03/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/662,534

Applicant(s)

IWATO ET AL.

Examiner

Yvette C. Thornton

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2003.
2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-19 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 09162003, 01142004, 0402 2004
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

This is written in reference to application number 10/662534 filed on September 16, 2003 and published as US 2004/0067435 A1 on April 8, 2004.

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The Information Disclosure Statements filed on September 16, 2003, January 14, 2004 and April 2, 2004 have been entered and fully considered.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

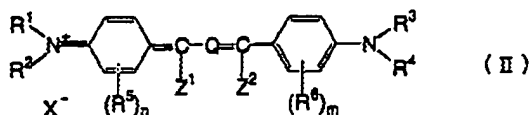
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

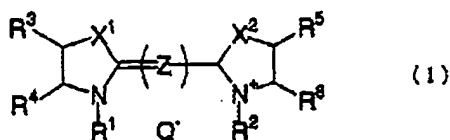
4. Claims 1, 4, 6-11 and 15-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakamura et al. (EP 1059164 A2). Nakamura teaches an image recording material comprising (a) an acid generating compound, (b) a crosslinking agent, (c) a water insoluble, alkali-soluble high polymer compound, (d) an infrared absorbing agent represented by formula (II):

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(p. 0008). Suitable examples of X- include BF₄,

SbF₆, trifluoromethyl sulfurous acid ions, and 4-hydroxybenzene sulfonic acid ions (p. 0090). It is the examiner's position that 4-hydroxybenzene sulfonic acid ions meet the limitations of a substituent having an alkali-dissociating proton as set forth in the instant claims 7-8 and 16-17. The taught material may also contain other pigments and infrared absorbing agents as long as the effectiveness of the taught invention is not impaired (p. 0099). See claim 18. The said acid generating compound is preferably any of those having an iodonium salt, phosphonium salt or diazonium salt of structures vi-viii (p. 0130). The anion is preferably R₇-SO₃⁻ wherein R₇ is a hydrocarbon group while may be substituted. Suitable examples of the said anion include methane sulfonate, 4-hydroxybenzenesulfonate and 2-hydroxy-4-methoxybenzenesulfonate (p. 0130-0133, 0138).

5. Claims 1-2, 6-11, 15 and 18-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakamura et al. (EP 1093934 A1). Nakamura teaches a photosensitive composition comprising an infrared absorbing agent represented by formula (I) and a water insoluble, alkali-soluble polymer compound:

(p. 0009). Suitable examples of Q- include BF₄, SbF₆,

trifluoromethyl sulfurous acid ions, and 4-hydroxybenzene sulfonic acid ions (p. 0038-0040). It is the examiner's position that 4-hydroxybenzene sulfonic acid ion meets the limitations of a substituent having an alkali-dissociating proton as set forth in the instant claims 7-8 and 16-17. The taught composition may also contain other pigments and infrared absorbing agents for improving the image forming properties (p. 0045). The said composition may also comprise other onium salts such as ammonium, phosphonium,

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iodonium and sulfonium. As the counter ion of the said onium salts, there are listed 2,4,6-trimethylbenzenesulfonic acid and p-toluenesulfonic acid (p. 0081-0085).

6. Claims 1-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Tsuchimura et al. (US 2003/0207203 A1). Tsuchimura teaches an image recording material comprising (a) an IR absorber and (b) a water insoluble and alkali soluble resin (p. 0014). The said IR absorber is preferably selected from the formulae (a) to (f-2) (p. 0136-0138, 0141-0160), wherein X represents a counter ion necessary for neutralization of the electric charge. Examples include halogen ion, tetrafluoroborate ion and sulfonic acid ion wherein sulfonic acid ion is particularly preferred (p. 0143, 0146, 0154, 0159). It is the examiner's position that formulae (a), (c), (d), (f-1) and (f-2) meet the limitations of claimed formula (A), (C), (D), (F-1) and (F-2), respectively. Furthermore, formula (b) meets the limitations of claimed formula (2) wherein Zb is onium salt. Specifically IR-30 and IR-31 meet the limitations of claimed formula (2) wherein Zb is a quaternary ammonium of given formula (M) (p. 0150-0151). Besides the said IR absorbers, dyes having a plurality of chromophores can be suitably used. Pigments can also be used as the IR absorber (p. 0161-0163). The taught dyes and pigments can be used singly or in admixture of two or more. In order to cope with an exposure machine with a plurality of wavelengths, it is desirable to combine dyes and pigments having different wavelengths (p. 0167).

7. The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

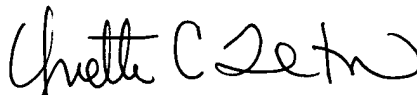
Conclusion

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yvette C. Thornton whose telephone number is 571-272-1336. The examiner can normally be reached on Monday-Thursday 8-6:30.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia H. Kelly can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Yvette Clarke Thornton
Primary Examiner
Art Unit 1752

yct
March 7, 2005